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(1)



# In the Supreme Court of the United States

OCTOBER TERM, 1945

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No. 1042

LINE MATERIAL COMPANY AND WILLIAM O.  
SCHULTZ, PETITIONERS

v.

CASPER W. OOMS, COMMISSIONER OF PATENTS

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE DISTRICT OF  
COLUMBIA

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BRIEF FOR THE RESPONDENT IN OPPOSITION

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## OPINIONS BELOW

The opinion of the District Court of the United States for the District of Columbia (R. 12-13) is not reported. The opinion of the United States Court of Appeals for the District of Columbia (R. 136-138) is reported at 152 F. (2d) 665.

## JURISDICTION

The judgment of the District Court was entered on January 18, 1943 (R. 16-17). The judgment of the Court of Appeals (R. 139) was entered on December 17, 1945. A petition for rehearing was denied on January 7, 1946 (R. 140). The petition

for a writ of certiorari was filed on April 2, 1946. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

#### QUESTIONS PRESENTED

1. Whether the disclosure made in the Schultz patent application No. 727,250 is insufficient to support the claims here involved.

2. Whether the District Court and the Court of Appeals were bound, in the absence of testimony on behalf of the defendant, to accept the testimony and conclusions of a skilled witness produced by the plaintiff.

#### STATUTES INVOLVED

The statutes involved, R. S. § 4888 (35 U. S. C. 33) and R. S. § 4915 (35 U. S. C. 63), are set forth in the Appendix, *infra*.

#### STATEMENT

Petitioners, Schultz, the applicant for a patent, and Line Material Company, his assignee, brought suit in the District Court of the United States for the District of Columbia under R. S. § 4915 to obtain a judgment which would authorize the Commissioner of Patents to issue a patent containing certain claims of the Schultz application, No. 727,250 (R. 2-8).

The application was filed in the Patent Office on May 24, 1934. It relates to

\* \* \* a novel form of fuse, such as the expulsion fuse type, in which the fuse tube operates first in the manner of an expulsion fuse, then moves downwardly and increases the gap in the circuit, and finally comes to rest projecting outwardly from the body portion so as to give a visual signal indicating that the fuse has blown. (R. 98.)

The primary examiner of the Patent Office allowed 49 claims of the application but refused to allow three other claims numbered 46, 48, and 49 (R. 113, 114) on the ground that they were not supported by the disclosure made in the application. This holding was affirmed by the Patent Office Board of Appeals (R. 122-124).

The District Court entered judgment dismissing the action (R. 16-17) on the ground that the Patent Office conclusions were not inconsistent with the evidence adduced before the court (R. 12). Petitioners appealed to the United States Court of Appeals for the District of Columbia, which affirmed on jurisdictional grounds (R. 128). This Court granted a writ of certiorari and reversed the judgment on the jurisdictional point, remanding the cause to the Court of Appeals for further proceedings. 325 U. S. 834. That Court (R. 136-139) thereupon affirmed the judgment of the District Court sustaining the action of the Patent Office.

The device disclosed in the Schultz application (R. 98-111) employs a fuse tube normally

held by a latch in an upper position. Within the tube is a fuse link which carries the current and which is adapted to break when an overload occurs. The fuse link is connected to the latch and holds it in latching position against the tension of a spring which is directly connected to the latch and tends to move it to released position. When the fuse link breaks, the latch is released by this spring. The fuse tube, being no longer supported by the latch, drops to a lower position. The downward movement of the fuse tube, after it is released by the latch, is expedited by a second spring, provided for this purpose.

As stated by petitioners (Pet. 17), the feature which is specifically in controversy and is variously stated in the three claims in issue (R. 113), is defined in claim 48 as follows:

\* \* \* means for moving the fuse tube longitudinally relative to said one of said fuse terminals *to release said locking means.*  
[Emphasis supplied.]

The claim was denied upon the ground that the second spring, which operates to expedite the downward movement of the fuse tube, is not the means for releasing the locking means (the latch), since the release of the latch is effected by the separate spring specifically provided on the latch for this purpose (R. 15).

At the trial in the District Court petitioners' expert witness produced and operated certain models based on the drawings of the Schultz

application (R. 32-80). The purpose of the demonstration was to show that when the locking means had been moved by its spring almost to its final released position, the second spring would have some effect in completing the release.

After this demonstration the District Court made the following finding of fact (R. 15) :

9. The degree to which the springs 15, 66, and 90 [the second spring described above, as variously numbered in drawings of variations of the device] may operate in the ultimate complete release of the latch is so slight as to be inconsequential and since the description of these springs and the operation thereof set forth in the specification of the Schultz application negatives the existence of any function thereof in effecting release of the latch, the application considered as a whole is not a disclosure of an apparatus in which the springs have this function.

The Court of Appeals in its decision stated (R. 138) :

An examination of the evidence offered at the trial seems to us to adequately support the result reached in the District Court. There is no question but that the spring actuating the latch arm must act first in effecting the release of the fuse tube. Otherwise the latch is useless in restraining the fuse tube from the circuit breaking position. This much being certain, the issue is narrowed to one of fact concerning the force, mode

of transmission, and time and direction of application exerted by the fuse tube [expedited by the second spring] to aid in opening the latch. We think the lower court justified in finding that the force flowing from the movement of the fuse tube was not necessary to the opening of the latch, that is to say, any force directed from the tube to the latch was gratuitous, not imperative to the unlatching.

#### ARGUMENT

The decisive question in this case is one of fact, namely, whether the disclosure made by petitioner was sufficient to support the claims here involved. The scope of appellate review in an action brought under the provisions of R. S. § 4915, insofar as it relates to a question of fact, is limited to the question of whether the finding that there was not sufficient disclosure is consistent with the evidence or is supported by the evidence. A proceeding under R. S. § 4915 is an equity action and follows the ordinary course of equity practice and procedure. *Butterworth v. Hoe*, 112 U. S. 50, 61. It is well established that the findings of fact of the trial court will not be disturbed unless clearly erroneous or without support in the evidence. *Borden's Farm Products Co., Inc. v. Ten Eyck*, 297 U. S. 251, 261; *Great Atlantic and Pacific Tea Co. v. Grosjean*, 301 U. S. 412, 420. The doctrine is applicable in principle to proceedings



under R. S. § 4915 and has been so applied by the court below in previous cases, e. g., *Abbott v. Coe*, 109 F. 2d 449, 451; *Forward Process Co. v. Coe*, 116 F. 2d 946, 947. It has peculiar force where, as here, the contested finding has been concurred in by both the Commissioner of Patents and the District Court. *Abbott v. Coe*, *supra* at p. 452; cf. *United States v. Commercial Credit Co., Inc.*, 286 U. S. 63, 67.

1. Throughout the petition the fact is emphasized that the claims at bar have been held patentable by respondent. This is true but immaterial to the question before the Court. That question is this: Does the Schultz application afford a basis for these claims? If not, then petitioners are not entitled to a patent based upon them regardless of whether the subject matter recited constitutes an invention. R. S. § 4888; *Railway Co. v. Sayles*, 97 U. S. 554, 563; *Schriber Co. v. Cleveland Trust Co.*, 305 U. S. 47, 57.

2. Also emphasized by petitioners is the fact that at the trial in the District Court respondent produced no witness to refute the testimony of petitioners' expert. Petitioners state (Pet. 22) that respondent "relied solely upon the unsworn-to actions of the Patent Office Staff \* \* \*." This is not an accurate statement, for at the trial respondent relied on the sworn statements made by petitioner Schultz himself in his application

that his devices did not operate in the manner required by the claims at bar.<sup>1</sup>

It is not accurate therefore to say that no evidence was offered to refute the testimony of peti-

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<sup>1</sup> In the original specification (R. 101, 105) Schultz described his device and its operation as follows (*italics supplied*):

"The operation of the apparatus is as follows: When the fuse blows and the fuse link is ruptured, the lower pivoted contact member 29 is released and swings in a clockwise direction under the influence of the spring 33 [the first spring described in the statement, *supra*]. *This withdraws the hooklike arms 29 from the rollers 27 and thus releases the fuse tube 11.*

\* \* \* \*

"The operation of the apparatus is as follows: When the fuse blows, the member 71 rocks in the direction indicated by the arrow under the influence of the members 69. The cam-shaped portions 87 engage the upper faces of the arms 85 and rock the latches 84 out of engagement with the pins 83, thus releasing the fuse tube and allowing the fuse tube to be projected downwardly by means of the spring 90, and also assisted by the action of gravity.

"It is to be noted that the construction of the latching member is such *that the force of the spring urging the fuse tube downwardly is not transmitted to the fuse link and, consequently, does not strain the fuse link.* This may be true of all forms of the invention, as illustrated, but is particularly true and particularly desirable where a spring is employed to urge the fuse tube downwardly."

His original claim 13 (R. 110) contains the following:

"\* \* \* a spring [the fuse tube spring], urging said fuse tube outwardly from said housing, latching means for normally restraining the outward motion of said fuse tube, a second spring urging said latching means toward releasing position, *the releasing motion of said latching means being independent of said first mentioned spring* [the fuse tube spring], and a fuse link electrically connecting said spaced contacts and restraining said latching means against releasing motion." [*Italics supplied.*]

tioners' expert. But even if there had been no evidence presented to refute the testimony and conclusions of the single expert witness produced by petitioners, the District Court was not bound to accept his testimony. A suit under R. S. § 4915 "is something in the nature of a suit to set aside a judgment, and as such is not to be sustained by a mere preponderance of evidence." It can be sustained only when the testimony "in character and amount carries thorough conviction." *Morgan v. Daniels*, 153 U. S. 120, 124, 125. "A mere preponderance of evidence' is not enough to justify reversing the Patent Office and deciding that an applicant is entitled to a patent." *Abbott v. Coe*, 109 F. 2d 449, 451.

It is clear from the findings and conclusions of the District Court that the expert's testimony was not persuasive that in petitioners' device the downward movement of the fuse tube, assisted by the spring which aids it, causes release of the latch. The demonstration models closely resembled the drawings of the Schultz application, but models made solely from drawings contain many characteristics beyond those found in the drawings, which may vitally affect the operation. In the present case, for example, the springs used in the models have certain strengths, the parts have certain weights, and there is a certain amount of friction between the moving parts. All of these characteristics may be varied by one

skilled in preparing models for demonstration purposes and cannot be gathered from drawings. Moreover drawings are of no avail to support a claim where there is an entire absence of description of the alleged invention or a failure to claim it. *Permutit Co. v. Graver Corp.*, 284 U. S. 53.

Here petitioners not only failed to provide a description of the operation required by the claims at bar, but their attempted description negatives such an operation. Hence the disclosure manifestly fails to meet the requirement of R. S. § 4888 that the application shall contain a full, clear, concise and exact description of the invention.

Petitioners urge (Pet. 8) that the court below found that the feature in question is inherent in the structure disclosed by Schultz. But the court below made no such finding. On the contrary, citing *Hansgirk v. Kemmer*, 102 F. 2d 212 (App. D. C.) and *Forward Process Co. v. Coe*, 116 F. 2d 946 (App. D. C.), it said (R. 137-138):

\* \* \* If, as appellants have endeavored to prove, the unlatching could not in fact take place without the force exerted by the fuse tube, it seems clear that the function claimed is inherent in the device. \* \* \*

\* \* \* However, in our opinion, even giving the appellants the benefit of the construction most favorable to their position, they have failed to prove their case.

\* \* \* \* \*

At best we believe no more was shown than that the fuse tube in biasing downward possibly contributes to the releasing action. This possibility is not sufficient to support the appellants' contention.

3. Petitioners seize upon the statement made in the decision of the lower court, that the District Court was right "in finding that the force flowing from the fuse tube was not necessary to the opening of the latch \* \* \*" and argue that this statement contravenes the principles of law announced by this court in the case of *Special Equipment Company v. Coe*, 324 U. S. 370. But the cases are in no sense parallel. Here the question is quite different and is whether the Schultz application discloses what is called for in the claims at bar. In the *Special Equipment Company* case the question was, as stated in the decision, p. 371,

whether the Court of Appeals correctly rested its decision upon the ground that petitioner did not intend to make or use the invention and that the purpose of seeking the patent was to exploit and protect the combination invention embodied in the complete machine, of which the subcombination is a part.

The court below did not say that in the instant device the fuse tube spring is not necessary. That spring has its function, namely, to aid gravity in

forcing the fuse tube downward as Schultz stated in his specification (R. 103). To say, as the lower court did, that in the Schultz device the downward movement of the fuse tube was not necessary to the opening of the latch, was merely to say that opening of the latch is not done by movement of the fuse tube.

4. The ruling of the lower court obviously does not impair the patent system or raise a question of "tremendous public importance" (Pet. 9) in the light of understood procedures. The decision merely means that petitioners may only establish claims which are covered by the Schultz application.

As above noted, the issue is one of fact, namely, whether petitioners' disclosure supports the claims in question. That issue is similar to the issues of patentability, infringement, and scope of claim which ordinarily are not reviewed by this court. *Keller v. Adams-Campbell Co.*, 264 U. S. 314, 319; *Layne & Bowler Corporation v. Western Well Works, Inc.*, 261 U. S. 387; *General Talking Pictures Corp. v. Western Electric Co.*, 304 U. S. 175.

#### CONCLUSION

The decision of the court is correct, there is no conflict, and the petition does not raise a question calling for review for any other reason. We re-

spectfully submit therefore that the petition for a writ of certiorari should be denied.

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April, 1946.